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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REPLY TO EXAMINER'S ANSWER TO APPEAL BRIEF	Atty. Docket No. **VIGN1200-1**

Applicant **Conleth S. O'Connell**	
Application Number **09/965,914**	Date Filed **Sept. 28, 2001**
Title **Method and System for Cache Management for Dynamically-Generated Content (as amended)**	
Group Art Unit **2141**	Examiner **Luu, Le H.**
Confirmation Number: **4230**	

Mail Stop: Appeal Brief- Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

Certification Under 37 C.F.R. §1.10

I hereby certify that this document is being deposited with the United States Postal Service with sufficient postage as Express Mail No. **EV887562304US** in an envelope addressed to: Appeal Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on **June 13, 2007**.

Julie H. Blackard
Signature

Julie H. Blackard
Printed Name

Appellant presents this Reply to the Examiner's Answer to the Appeal Brief mailed on April 13, 2007. Appellant respectfully requests that this Reply to the Examiner's Answer be considered in this appeal by the Board of Patent Appeals and Interferences.

I. STATUS OF CLAIMS

Claims 1-61 were originally filed with the application. The claims were rejected in office actions dated March 25, 2005, November 23, 2005 and April 11, 2006. The claims have not been amended and stand rejected under 35 U.S.C. §103(a) as being obvious in light of the combination of United States Patent No. 6, 591,266 issued to Li ("Li") and United States patent No. 6,696,849 issued to Carlson ("Carlson"). Claims 1-61 are being appealed herein.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

In the April 11, 2006 Office Action (the "April 11 Office Action"), the Examiner rejected Claims 1-61 under 35 U.S.C. §103 (a) as being unpatentable over United States Patent No. 6,591,266 ("Li") in view of United States Patent No. 6,697,879 ("Carlson"). In rejecting Claims 1-61, the Examiner applied an inappropriate standard and failed to consider the merits of a 37 C.F.R. 1.131 Declaration (the "Declaration") as showing conception. The grounds for rejection to be reviewed are whether the Examiner erred in determining that the facts of the 37 C.F.R. 1.131 Declaration do not show conception such that the date of conception of the present invention is prior to the effective date of the Li reference.

III. REPLY TO THE EXAMINER'S COMMENTS

The Examiner's Answer essentially reiterated the rejections of the April 11, 2006 Office Action and continues to disregard the statements of the inventor O'Connell and cite portions of the MPEP inapplicable to conception in maintaining the rejection.

Appellants note that "averments made in a 37 C.F.R. 1.131 affidavit or declaration do not require corroboration; an inventor may stand on his or her own affidavit if he or she so elects." *See* MPEP 715.07 (emphasis added). Moreover, "in reviewing a 37 C.F.R. 1.131 affidavit or declaration, the examiner must consider all the evidence presented in its entirety." See MPEP 715.07 (emphasis added).

The Declaration was submitted with an August 25th Reply to an Office Action Dated March 25, 2005 (the "August 25th Reply") and with a reply dated February 23, 2005 (the "February 23 Reply"). The Declaration included an email drafted by Mr. O'Connell as Exhibit A and a software specification distributed by the inventors that described in the claimed invention

as Exhibit B. A copy of the Declaration, Exhibit A and Exhibit B are included in the Evidence Appendix of the Appeal Brief. Mr. O'Connell averred to the following facts: the claimed invention was conceived at least as early as January 7, 2000 (*see* Declaration, page 1, ¶2); the email attached as Exhibit A to the Declaration was drafted on January 7, 2000 (*see* Declaration, page 1, ¶3); the specification attached to Exhibit B of the declaration was drawn up prior to January 7, 2000 (*see* Declaration, page 1 ¶4); and the specification attached as Exhibit B demonstrates conception of the invention as described and claimed in the patent application, (*see* Declaration, page 1 ¶5). Mr. O'Connell acknowledged that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. (*see* Declaration, page 1 ¶6).

Mr. O'Connell, however, was not given the benefit of his statements as they appear to have been disregarded. The trend of disregarding statements in the Declaration was established early in the prosecution history. As initially pointed in the Appeal Brief filed December 22, 2006 (the "Appeal Brief"), the Examiner baselessly questioned the veracity of Mr. O'Connell's statements regarding the date of an email exhibit to the Declaration stating "the validity of the email in Exhibit A is questionable because Examiner notes that [sic] time stamp and subject header of the mail in Exhibit A are missing." *See* Appeal Brief, page 10 (emphasis added). The Examiner made this statement despite the fact that Mr. O'Connell swore to the date of the email. This provides evidence the Examiner did not believe the truth of statements in the Declaration and that the statements of Mr. O'Connell are not being properly considered.

The Examiner's disregard for Mr. O'Connell's statements is further evidenced by the Examiner's Answer, which states "the Exhibits do not provide sufficient evidence to establish conception." *See* Examiner's Answer, page 9. This makes no mention of Mr. O'Connell's averments in the Declaration.

Furthermore, the Examiner appears to be seeking more than is necessary to establish conception. In the Examiner's Answer, the Examiner states:

> The affidavit or declaration and exhibits must clearly explain which facts or data Appellant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what exhibits describe along with a general assertion that the exhibits describe a reduction to practice 'amounts to mere pleading, unsupported by proof or showing of facts' and, thus does not satisfy the requirements of 37 C.F.R. 1.131 (b). *See*, Examiner's Answer, page 4 [Emphasis Added].

The Examiner's statement is drawn to evidence regarding reduction to practice, not conception, specifically suggesting the Declaration must show "facts or data applicant is relying on to show completion of his or her invention prior to the particular date." MPEP 715.07.

Reduction to practice, however, is not required to show conception and is not at issue in the Declaration. The date of reduction to practice relied upon for purpose of the August 25 and February 23 Replies is the date of filing of the provisional application as stated in the August 25 Reply and subsequent replies. *See e.g.,* August 25 Reply, page 5. Thus, in addition to giving no apparent weight to Mr. O'Connell's statements, the Examiner failed to consider the merits of the Declaration with respect to conception by seeking evidence of reduction to practice.

The Examiner disregarded the statements in the Declaration itself and even implied that some statements may be untrue. The Examiner then erroneously sought evidence of completion or reduction of practice. Appellant submits, however, that the Declaration was submitted to show conception and does so in its merits.

Mr. O'Connell's averments and the evidence as a whole shows that the inventors had "more than a vague idea of how to solve a problem." Mr. O'Connell has averred to the fact that he conceived the claimed invention at least as early as January 7, 2000 and that the conception of the invention is demonstrated in Exhibit B of his Declaration. *See* August 25 Reply, Exhibit 1, page 1, ¶2, 4, 5. Moreover, Mr. O'Connell has provided more than necessary as he has provided corroborating evidence, in the form of Exhibit B of the Declaration, demonstrating conception of this invention. Mr. O'Connell should be able to rely on his averment that the invention was conceived at least as early as January 7, 2000 and that Exhibit B of the

Declaration demonstrates conception without having to convince the Examiner that sworn statements are correct.

Moreover, Exhibit B of the Declaration, on its face, is a "Cache Management Regeneration Design" document listing the requirements for an embodiment of a cache manager and specifically specifying modifications to an embodiment of cache manager. The email of Exhibit A of the Declaration provides evidence that the inventors distributed the specification of Exhibit B for purposes of implementation, demonstrating that the inventors had much more than "a mere vague idea of how to solve the problem . . . ." Specifically, the email, in discussing the specification of Exhibit B of the Declaration, states, "I'm hoping it is clear enough. If not I'm available to talk about. If any other issues come up as you go through the implementation . . . ." *See* Declaration, Exhibit A (referring to Exhibit B in which Mr. O'Connell provides a detailed specification showing conception of the invention). Thus, it is clear that the specification of Exhibit B was designed to allow others to implement an embodiment of the invention.

The Declaration provides evidence of conception at least as early as January 7, 2000 in the form of statements by Mr. O'Connell, email communications and the specification of Exhibit B. Mr. O'Connell stated in the Declaration that the specification of Exhibit B shows conception and the specification of Exhibit B demonstrates the inventors had more than "a vague idea of how to the solve the problem." Additionally, the email attached as Exhibit A of the Declaration demonstrates that the specification of Exhibit B was distributed for purposes of implementation. Thus, the evidence as a whole demonstrates conception of the invention.

Conclusion

The Declaration and attached exhibits clearly demonstrate conception at least as early as January 7, 2000. The Examiner's repeated rejections based on the belief that the Declaration fails to show conception should be withdrawn.

While Appellant believes no fees are due and owing for filing this Reply, if Appellant is in error, the Commissioner is hereby authorized to deduct the appropriate amount from Deposit Account No. 50-3183 of Sprinkle IP Law Group.

Respectfully submitted,
Sprinkle IP Law Group

John L. Adair
48,828

Date: June 13, 2007

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